

ATTORNEY DOCKET NO. 114596-05-4013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/239,194 Confirmation No.: 9716
Applicant: John S. Yates, Jr., et al.
Title: COMPUTER WITH NON-NATIVE OPERATING SYSTEM
Filed: January 28, 1999
Art Unit: 9716
Examiner: Kenneth Tang

Atty. Docket: 114596-05-4013
Customer No. 38492

AFTER FINAL – EXPEDITED PROCEDURE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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This is a request for Pre-Appeal Brief Review.

I. Bases for Reversing the Examiner

One particular error pervades all prior art issues raised in the Office Action: the Office Action picks out a few isolated words of the claim, and compares them to a few isolated words in the references, without considering either the claims or the references as a whole. It appears that Examiner Tang simply did a naïve word search for a few isolated words, found a reference that uses a few similar words, but never analyzed either the claims or reference to ensure that the references' components are arranged as recited in the claims. The Office Action seems to assume that different things mentioned in the references with slightly similar names are the same thing. Conversely, the Office Action often treats two mentions of the same thing in the claims as

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being unrelated to each other, so that the same component in the claim may be met by a collection of unrelated things in the references. The Office Action ignores the arrangement recited in the claims, and the entirely different arrangement in the references.

Examiner Tang's technological analysis is similarly flawed: he repeatedly seems to confuse entirely different things with each other, such as "instruction," "architecture," "exception handler," "data frame," and the like.

Remarkably, Examiner Tang's new primary reference (Robinson 6,199,095) is very nearly word-for-word identical to the reference (Chernoff 6,000,028) considered by the Appeal Conference in September 2005. The new primary reference is being cited for essentially the same teachings as the old primary reference. Thus, this Pre-Appeal is directed to issues very similar to those already considered by the Appeal Conference, issues where the Examiner has previously been reversed.

The following clear errors and omissions are discussed in more detail in the accompanying Request for Reconsideration:

§ 112 ¶ 2

The Office Action makes no showing of ambiguity or lack of clarity. Indeed, the Office Action explains that most of the language at issue is clear and unambiguous.

Claim 5

The Office Action does not clearly designate any portion of any reference or any component as corresponding to the "extended context including resources ... beyond those ... maintained by the thread scheduler." This claim limitation has been at issue for several Office Actions – the failure to particularly designate any corresponding element of any reference is striking. The Office Action notes the presence of "resources" and a "scheduler" but **makes no attempt whatsoever to show that they are arranged as recited in claim 5.**

The Office Action reflects unfamiliarity with the most basic legal principles. Though this application has now been pending for **over seven years**, and Applicant has repeatedly requested showings on all *prima facie* elements for any ground on which allowance is withheld, **no Office Action has ever made any complete *prima facie* showing on any ground of rejection.**

The misunderstanding of the law of obviousness is especially stark. Where the MPEP clearly delineates at least five separate underlying issues (motivation to modify or

combine, reasonable expectation of success, all claim limitations taught or suggested, analogous and non-analogous art, and secondary factors), the Office Action reflects a lack of recognition of the differences and interrelationships among these underlying issues.

The Office Action asserts that certain language is “not recited in ... the claim.” The Office Action is simply wrong on this most basic fact, as demonstrated by the claim language set forth in bold in the Response to Office Action.

Claim 33

The Office Action does not clearly designate any portion of any reference as corresponding to the “resumption exception” of claim 33, or to show that any such exception is “complementary to” another component, as recited in claim 33. This claim limitation has been at issue for several Office Actions – the failure to particularly designate any corresponding element of any reference is surprising.

Several factual assertions regarding the content of the Robinson '095 reference are baldly asserted by Examiner Tang, with no citation to or support in the reference. His assertions are simply wrong.

Claim 55

The discussion of claim 55 in the Office Action is vague – there has been no attempt to set forth the required findings to raise any rejection.

The office Action misquotes the references.

The Office Action fails to identify any portion or component of any reference to correspond to the “entry handler” recited in claim 55, even though that claim limitation has been at issue for three years.

The Office Action confuses the different issues that underlie obviousness, and makes no *prima facie* showing.

Claim 79

The Office Action does not clearly designate any portion of any reference as corresponding to the “linkage return address ... deliberately chosen so that an attempt to execute .. will raise a program execution exception” recited in claim 79. This claim limitation has been at issue for over three years – the silence in the Office Action raises troubling questions of the Examiner’s competence and good faith.

II. Request for Observance of the PTO’s Procedural Rules in Any Further Proceedings

Another troubling pattern has emerged: the PTO’s procedural rules seem to be given short shrift. There has been no *bona fide* effort by the examiner to comply with the PTO’s procedural rules for examination in over three years, and the Office Action now at issue

continues the trend of simply ignoring rules that the examiner considers inconvenient. Examiner Tang states that it is too “burdensome” to set forth a complete consideration of the independent claims as required by the rules (Action of 4/3/2006 ¶ 13), or to consider all elements of *prima facie* obviousness (¶¶ 10, 11). Is this the policy in the art unit? *See* Summary of Interview With Supervisory Examiner Meng An, IFW 7/24/2005 (Supervisory An states that she disregards Federal Circuit precedent on procedural issues, and does not require her examiners to follow the PTO’s procedural rules).

Notably, over the last three weeks, the undersigned attorney has made a number of contacts with Examiner Tang and Supervisory Examiner An to request an interview. PTO policy is that these contacts are to be returned in one business day. They have not been returned at all.

At ¶ 7, the Office Action asserts that an examiner has personal authority to reopen prosecution on the same reference after the examiner is reversed. MPEP § 1214.04 disagrees. After an examiner is reversed, any reopening of prosecution requires the approval of a T.C. Director “placed on the action reopening prosecution.” No such approval appears in the record. If prosecution is now reopened after a Second Pre-Appeal Conference, the MPEP requires the signature of the T.C. Director.

At ¶ 18, the Examiner asserts that an interview was had on September 30, 2005. The Examiner cites no evidence. The first Office Action after the appeal conference was mailed on September 30, 2005. On that date, the application was effectively in the PTO mailroom, and before neither the examiner or this applicant. Applicant could not possibly know even what references were at issue, let alone discuss them meaningfully, before the Office Action arrived and could be read. No interview summary is in the record. The Examiner’s statement is unfounded.

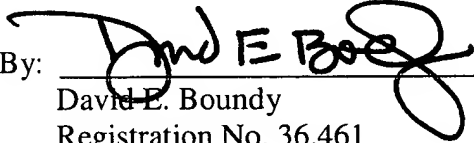
If there is to be any further reopening or further prosecution of this application, Applicant respectfully requests that PTO procedures be observed.

It is believed that this paper occasions no fee. Kindly charge any fee due to Deposit
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Respectfully submitted,

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Dated: June 20, 2006

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